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FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER
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WASHINGTON, DC 20005

EXAMINER

LE, HUYEN D

ART UNIT	PAPER NUMBER
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3751

DATE MAILED: 06/30/2003

15

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/691,944

Applicant(s)

JEAN-LOUIS GUERET

Examiner

Huyen Le

Art Unit

3751

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 April 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-172 is/are pending in the application.
- 4a) Of the above claim(s) See Continuation Sheet is/are withdrawn from consideration.
- 5) ☒ Claim(s) 13 and 80 is/are allowed.
- 6) ☒ Claim(s) 1-3, 7-12, 29-35, 38-43, 45, 48, 49, 52-65, 59-81, 84-86, 88-99, 103-108, 116-130, 134-139, 147-161, 163-172 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____

4) ☐ Interview Summary (PTO-413) Paper No(s). _____

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____

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PTO-326 (Rev. 04-01)

Office Action Summary

Part of Paper No. 15

Continuation of Disposition of Claims: Claims withdrawn from consideration are 4-6,14-28,36,37,44,46,47,50,51,57,58,82,83,87,100-102,109-115,131-133,140-146 and 162.

Art Unit: 3751

DETAILED ACTION

Election/Restrictions

1. Applicant has previously elected Species II (b), Figures 5 and 6 for prosecution. Therefore, claims 4-6, 14-28, 36, 37, 44, 46, 47, 50, 51, 57, 58, 82, 83 and new claims 87, 100-102, 109-115, 131-133, 140-146 and 162 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to nonelected species I and II (a).

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-3, 7-12, 29, 30, 32-35, 41-43, 48, 49, 52, 53, 56, 59-65, 70-79, 81, 84-86, 89-97, 129, 130, 134-139, 148, 149, 151-155, 157-161, 164-172 are rejected under 35 U.S.C. 102(b) as being anticipated by Capezzuto (3,132,370).

The Capezzuto reference discloses an applicator comprising a reservoir 10, a removable closure 20, an applicator member 36 having a product application surface movable between a first position wherein it extends out of the reservoir (Fig. 3) and a second position wherein it is substantially contained in the reservoir (Fig. 2), and an elastically compressible support 34 supporting the applicator member 36 and the support 34 having a compressibility greater than the compressibility of the applicator member 36.

Regarding claims 7-10, 77-79, 95-97, 134-136 and 170-172, the support 34 includes a block of foam (col. 2, lines 59-60).

Regarding claims 11, 12 and 139, the applicator member 36 is attached to the support 34 by crimping by flange 28.

Art Unit: 3751

Regarding claims 29 and 30, the product application surface of the applicator member 36 has a convex profile or a dome (Fig. 3).

Regarding claim 32, the applicator member 36 includes a perforated element (col. 2, lines 65-66).

Regarding claims 41-43, 89-91 and 151-153, the reservoir includes a compressible body which is a deformable tube (col. 2, line 16).

Regarding claims 59-62, 84 and 156-158, all functional statements of the intended use have been carefully considered but deemed not to impose any structural limitations on the claims distinguishable over the applicator device of Capezzuto which is capable of being used to apply any kind of cosmetic products, glue, correction fluid, and a stain remover.

Regarding claims 63 and 159, the method of applying a cosmetic product is inherently performed during normal operation of the applicator.

Regarding claim 64, the applicator device comprises an absorbent member having a first portion 36 configured to apply a liquid product to a surface and a second support portion 34 configured to elastically support the first portion 36, wherein the first portion 36 has a different density than the second portion (because of material differences).

Regarding claim 81, the applicator member 36 includes a recessed portion which is an area located under the lower surface of the applicator member as shown in Figs. 2 and 3.

Regarding claim 85, the second end portion of the applicator 36 is in a first position, the application member 36 is in flow communication with the reservoir.

4. Claims 64, 70-73, 75-79, 89-92, 94-97, 160, 164-167, 169-172 are rejected under 35 U.S.C. 102(b) as being anticipated by Barlow et al (2,837,756).

The Barlow et al reference discloses an applicator comprising a reservoir 72 for containing a liquid product having an opening, an absorbent member provided in fluid

Art Unit: 3751

communication with the reservoir, the absorbent member including two portions, a first application portion 98 for applying the liquid product, and a second support portion 100 for elastically supporting the first portion 98, wherein the first portion has a different density than the second portion 100, and the absorbent member is compressible.

Regarding claims 84 and 156-158, all functional statements of the intended use have been carefully considered but deemed not to impose any structural limitations on the claims distinguishable over the applicator device of Barlow which is capable of being used to apply any kind of cosmetic products.

Regarding claims 95-97 and 170-172, the support portion 100 includes one block of an elastically deformable material (foam).

5. Claims 1-3, 11, 31-35, 41-43, 48, 49, 52, 56, 59-63, 85, 98, 99, 107, 116-118, 120-124, 126-131, 138, 147-149, 151-155, 157-159 are rejected under 35 U.S.C. 102(b) as being anticipated by Fraleigh (4,225,253).

The Fraleigh reference discloses an applicator comprising a reservoir 12; a removable closure 50; an applicator member 30 having a first end portion and a second end portion, the second end portion including a product application surface and being axially movable between a first position wherein it extends out of the reservoir 12 and a second position wherein it is substantially contained in the reservoir; and an elastically compressible support 34 supporting the applicator member 30 and the support 34 having a compressibility greater than the compressibility of the applicator member 30.

Regarding claims 59-62, 126, 127 and 156 -158, all functional statements of the intended use have been carefully considered but deemed not to impose any structural limitations on the claims distinguishable over the applicator device of Fraleigh which is capable of being used to apply any kind of cosmetic products, glue, correction fluid, and a stain remover.

Art Unit: 3751

Regarding claims 63, 128 and 159, the method of applying a cosmetic product is inherently performed during normal operation of the applicator.

Regarding claim 145, the applicator device further comprises a perforated element 22 separating the housing 24 from the liquid product in the reservoir 12.

6. Claims 1-3, 7-12, 29, 30, 32-35, 41-43, 48, 49, 52, 53, 56, 59-65, 70-79, 84-86, 89-97, 129, 130, 134-139, 148, 149, 151-155, 157-161, 164-172 are rejected under 35 U.S.C. 102(b) as being anticipated by Schwartzman (3,266,079).

The Schwartzman reference discloses an applicator comprising a reservoir 10, a removable closure 76, an applicator member 21 having a product application surface movable between a first position wherein it extends out of the reservoir (Fig. 3) and a second position wherein it is substantially contained in the reservoir (Fig. 3), and an elastically compressible support 20 supporting the applicator member 21 and the support 20 having a compressibility greater than the compressibility of the applicator member 21.

Regarding claims 7-10, 77-79, 95-97, 134-136 and 170-172, the support 34 includes a block of foam.

Regarding claims 11, 12 and 139, the applicator member 36 is attached to the support 34 by bonding.

Regarding claims 29 and 30, the product application surface of the applicator member 36 has a convex profile or a dome (Fig. 2).

Regarding claim 32, the applicator member 36 includes a felt.

Regarding claims 41-43, 89-91 and 151-153, the reservoir includes a compressible body which is a deformable tube.

Regarding claims 63 and 159, the method of applying a cosmetic product is inherently performed during normal operation of the applicator.

Art Unit: 3751

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 38-40, 67-69, 88, 150 and 163 are rejected under 35 U.S.C. 103(a) as being unpatentable over Capezzuto (3,132,370).

The Capezzuto reference discloses an applicator device as described above.

Although the Capezzuto reference is not specific as to what sizes the open cells of the foam support 34 should be, it would have been obvious to one of ordinary skill in the art at the time the invention was made to select a size for open cells of the foam support within a certain range to best fit a particular applicator depending on a liquid applied and to optimize the performance of the applicator. See *In re Aller*, 105 USPQ 233, using the optimum or workable ranges involves only routine skill in the art.

9. Claim 45 is rejected under 35 U.S.C. 103(a) as being unpatentable over Capezzuto (3,132,370) in view of McCabe et al (2,659,919).

The Capezzuto reference discloses an applicator device as described above.

Although the Capezzuto applicator device does not include a diaphragm portion on the reservoir 10, attention is directed to the McCabe et al reference which discloses another applicator device comprising a reservoir 12 having a diaphragm portion 14a for facilitating delivering the liquid 12 to an applicator member 17.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ a reservoir with a diaphragm in the Capezzuto applicator device

Art Unit: 3751

in view of the teaching of the McCabe et al reference in order to facilitating delivering the fluid to the applicator member.

10. Claim 54 is rejected under 35 U.S.C. 103(a) as being unpatentable over Capezzuto (3,132,370).

The Capezzuto reference discloses an applicator device comprising a closure member 20 including an element 38 of liner configured to engage the application surface.

Although the Capezzuto reference does not specifically disclose that element is made of a foam material, it would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute a foam element with a liner element inside the Capezzuto cap, wherein, wherein so doing would amount a mere substitution of one functional equivalent a cushion means for another within the same art that would work equally well in the Capezzuto reference device.

11. Claims 55 and 156 are rejected under 35 U.S.C. 103(a) as being unpatentable over Capezzuto (3,132,370).

The Capezzuto reference discloses an applicator device as described above.

Although the Capezzuto reference is not specific that the compressibility of the support 34 is two to four times greater than the compressibility of the applicator member 36, it would have been obvious to one of ordinary skill in the art at the time the invention was made to select a support having a certain compressibility range to best fit a particular applicator design and to optimize the performance of the applicator. See *In re Aller*, 105 USPQ 233, using the optimum or workable ranges involves only routine skill in the art.

12. Claims 65, 86 and 161 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barlow et al (2,837,756) in view of Fraleigh (4,225,253)

Art Unit: 3751

Although the Barlow et al reference does not show that the applicator device having a removable member for sealably closing the opening, attention is directed to the Fraleigh reference which discloses another applicator having a closure member for sealing closing the opening and protecting the application head.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ a cap on the Barlow et al reference in view of the teaching of the Fraleigh reference for sealing closing the opening and protecting the application head.

13. Claims 67-69, 88 and 163 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barlow et al (2,837,756)

The Barlow et al reference discloses an applicator device as described above.

Although the Barlow et al reference is not specific as to what sizes the open cells of the foam support 34 should be, it would have been obvious to one of ordinary skill in the art at the time the invention was made to select a size for open cells of the foam support within a certain range to best fit a particular applicator depending on a liquid applied and to optimize the performance of the applicator. See In re Aller, 105 USPQ

14. Claims 38-40, 119 and 150 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fraleigh (4,225,253).

The Fraleigh reference discloses an applicator device as described above.

Although the Fraleigh reference is not specific as to what sizes the open cells of the foam support 34 should be, it would have been obvious to one of ordinary skill in the art at the time the invention was made to select a size for open cells of the foam support within a certain range to best fit a particular applicator depending on a liquid applied and to optimize the performance of the applicator. See In re Aller, 105 USPQ 233, using the optimum or workable ranges involves only routine skill in the art.

Art Unit: 3751

15. Claim 45 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fraleigh (4,225,253) in view of McCabe et al (2,659,919).

The Fraleigh reference discloses an applicator device as described above.

Although the Fraleigh applicator device does not include a diaphragm portion on the reservoir 10, attention is directed to the McCabe et al reference which discloses another applicator device comprising a reservoir 12 having a diaphragm portion 14a for facilitating delivering the liquid 12 to an applicator member 17.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ a reservoir with a diaphragm in the Fraleigh applicator device in view of the teaching of the McCabe et al reference in order to facilitating delivering the fluid to the applicator member.

16. Claims 55, 125 and 156 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fraleigh (4,225,253).

The Fraleigh reference discloses an applicator device as described above.

Although the Fraleigh reference is not specific that the compressibility of the support 34 is two to four times greater than the compressibility of the applicator member 36, it would have been obvious to one of ordinary skill in the art at the time the invention was made to select a support having a certain compressibility range to best fit a particular applicator design and to optimize the performance of the applicator. See *In re Aller*, 105 USPQ 233, using the optimum or workable ranges involves only routine skill in the art.

17. Claims 38-40, 67-69, 88, 150 and 163 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schwartzman (3,266,079)

The Schwartzman reference discloses an applicator device as described above.

Art Unit: 3751

Although the Schwartzman reference is not specific as to what sizes the open cells of the foam support 34 should be, it would have been obvious to one of ordinary skill in the art at the time the invention was made to select a size for open cells of the foam support within a certain range to best fit a particular applicator depending on a liquid applied and to optimize the performance of the applicator. See *In re Aller*, 105 USPQ 233, using the optimum or workable ranges involves only routine skill in the art.

18. Claim 45 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schwartzman (3,266,079) in view of McCabe et al (2,659,919).

The Schwartzman reference discloses an applicator device as described above.

Although the Schwartzman applicator device does not include a diaphragm portion on the reservoir 10, attention is directed to the McCabe et al reference which discloses another applicator device comprising a reservoir 12 having a diaphragm portion 14a for facilitating delivering the liquid 12 to an applicator member 17.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ a reservoir with a diaphragm in the Schwartzman applicator device in view of the teaching of the McCabe et al reference in order to facilitating delivering the fluid to the applicator member.

19. Claims 55 and 156 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schwartzman (3,266,079).

The Schwartzman reference discloses an applicator device as described above.

Although the Schwartzman reference is not specific that the compressibility of the support 34 is two to four times greater than the compressibility of the applicator member 36, it would have been obvious to one of ordinary skill in the art at the time the invention was made to select a support having a certain compressibility range to best fit a particular applicator design

Art Unit: 3751

and to optimize the performance of the applicator. See *In re Aller*, 105 USPQ 233, using the optimum or workable ranges involves only routine skill in the art.

Response to Arguments

20. Applicant's arguments filed on March 10, 2003 in the Amendment (paper no. 11) have been fully considered but they are not persuasive.

In regard to applicant's arguments that the membrane 36 of Capezzuto is not an "absorbent" material, the Capezzuto reference discloses the membrane 36 being a permeable membrane which may be formed of fabrics of artificial or natural fibers (col. 1, lines 53-57 and col. 2, lines 64-66). To an extent, fabrics of natural or artificial fibers for example, cotton or polyester, inherently have an absorbency property and are capable of absorbing liquid. Therefore, the membrane of Capezzuto is considered as an "absorbent " material as claimed.

Allowable Subject Matter

21. Claims 13 and 80 are allowed.

Conclusion

22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Huyen Le whose telephone number is 703-306-5504. The examiner can normally be reached on Monday-Friday from 9:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Huson can be reached on 703-308-2580. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7766 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0861.


Application/Control Number: 09/691,944

Art Unit: 3751

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June 25, 2003

Page 12



Gene Mancene
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